

REMARKS

I. Introduction

In response to the pending Decision on Appeal, Applicants have amended claim 32. No new matter has been added.

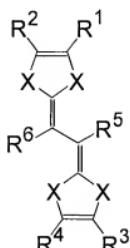
A Request for Continued Examination (RCE) is being filed concurrently with this Amendment.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art.

II. The Rejection Of Claims 22, 25, 28, 32, 35, 38, 41, 44, 50 and 53

Claims 22, 25, 28, 32, 35, 38, 41, 44, 50 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. (USP No. 6,110,619) in view of Carlier et al. (Publication *Electrochimica Acta*). Applicants respectfully traverse this rejection for at least the following reasons.

With regard to the present disclosure, claim 32 recites, in-part, a secondary battery, comprising a positive electrode, a negative electrode and an electrolyte, wherein at least one of said positive electrode and said negative electrode includes an electrode active material comprising a compound having a structure represented by the general formula (1a):



where X is an oxygen atom.

It was admitted in the Office Action that Zhang fails to teach the specific compound of formula 1(a). It was found that Zhang teaches that the positive electrode active material has an organo-sulfur structure. As the compound of general formula 1(a), as currently amended, does not have an organo-sulfur structure (X = oxygen), Applicants submit that Zhang fails to teach or suggest amended independent claim 32.

Moreover, Carlier appears silent with respect to the use of a compound of formula 1(a). As admitted by the Examiner, Carlier discloses an organo-sulfur compound. As can be seen in the compound of Carlier does not disclose a compound of general formula 1(a) where X = O. Therefore, neither Zhang, nor Carlier teach or suggest all of the limitations of claim 32 of the present disclosure.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. At a minimum, as Zhang and Carlier fail to teach or suggest a secondary battery, comprising a positive electrode, a negative electrode and an electrolyte, wherein at least one of said positive electrode and said negative electrode includes an electrode active material comprising a compound having a structure represented by the general formula (1a), where X = oxygen, it is submitted that Zhang and Carlier, alone or in combination, do not render claim 32 obvious. Accordingly, it is respectfully requested that the § 103 rejection of claim 32 be withdrawn.

III. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 32 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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